

REMARKS

This Amendment is preliminarily to the issuance of an office action in the above identified application.

With the present Amendment applicants have first of all amended claim 16 to correct the typing error by changing the term "said driving spindle" to -- said drilling spindle --.

As for the Examiner's requirement to submit a marked-up copy of the abstract in the Office Action, it is respectfully submitted that the original abstract was canceled and a new abstract was submitted, so that no marked-up copy is needed. In connection with the Examiner's objection to claim 8, line 16 "the torque transmission" as lacking sufficient antecedent basis, it is respectfully submitted that in this claim before this term "a torque transmission" is mentioned, and therefore the use thereafter of the term "the torque transmission" is justified.

The claims are rejected under 35 U.S.C. 103(a) over the patent to Bitter in view of the patent to Tsai, and for some claims also in combination with the patent to Zagar.

Applicants have retained the original claims as they were and submitted two new independent claims 17 and 18. Claim 17 defines additionally that the drilling spindle performs an axial percussion movement, and also defines that the arresting device allows clamping and releasing a tool in the tool holder or connecting the tool holder to and removing the tool holder from the drilling spindle. Claim 18 is substantially similar to claim 17 but does not define the arrangement of the arresting device between the intermediate shaft and a machine housing or its component. These two claims specifically define that while the arresting device allows clamping and releasing a tool in the tool holder and connecting and disconnecting the tool holder relative to the drilling spindle, it is located so that it is not subject to strikes of the impact mechanism. These two claims by specifying that tool holder is directly connected to the drilling spindle clearly define that the drilling spindle is an output shaft of the hand-guided percussion drilling machine.

Turning now to the Examiner's grounds to the rejection of the claims, it is respectfully submitted that the patent to Bitter discloses a hammer drill as described by the Examiner. The patent to Tsai teaches an arresting device for use in an electric tool and the like. The point at issue is

where a person skilled in the art would place the arresting device by Tsai in an electric tool, for example in the hammer drill by Bitter. }

The patent to Tsai is very clear in this point. The arresting device is to be placed "... in an output shaft of an electric hand tool ..." as explained in column 1, lines 58-59. It further indicates that: "the lock mechanism is disposed between an inner shaft 10 and an outer shaft 60 of the output shaft", as described in column 2, lines 33-35. There is absolutely no reason for anyone skilled in the art to place the arresting device at any other place than in the output shaft of the electric tool.

The Examiner stated that it would have been obvious to one having ordinary skill in the art to have added the automatic output shaft arresting device taught by Tsai to the drill taught by Bitter in such a way that it replaces a portion of the motor shaft 25 taught by Bitter (paragraph 8, last sentence). In order not to contradict Tsai who teaches to place the locking device in an output shaft, the Examiner calls the shaft 25 "motor output shaft" (paragraph 14, first sentence). In the Examiner's opinion this is the reason why it is possible to place the locking device there because shaft 25 is an "output shaft".

It is irrelevant whether the shaft 25 is called “motor shaft” as Bitter calls it or motor output shaft as the Examiner does. Tsai is clear in saying “output shaft of an electric hand tool “ (column 1, lines 58 and 59 and lines 18-19). It is not the output shaft of the motor but of the tool. The output shaft of a tool is the shaft which comes out of the tool and which displaces the spindle of the tool and which provides an axial percussion, and which also rotates the spindle of the tool and which provides the outputting torque. The output shaft therefore is a shaft which is equivalent to the drilling spindle as disclosed in the description of the present invention and defined in the claims currently on file, in particular since the claims define that the tool holder is connected (directly) to the drilling spindle. The motor shaft 25 of Bitter is not an output shaft, because the tool holder is not connected to it. Tsai confirms that in stating: “...output shaft... for outputting torque” (column 2, lines 35-36).

In light of the patent to Tsai anything else does not make sense because it is the output shaft of the tool or the spindle of the tool which is the object to be locked and not any other component inside any gearing mechanism of the tool. It is not the gearing or any component therein which is to be locked but instead the output shaft of the tool or the drilling spindle as in the present invention. It does not also make any sense to place the

locking device at any place away from the component to be locked: THE OUTPUT SHAFT OF THE TOOL. It is noted that these facts of the case are independent of how someone calls any component inside the tool.

In the applicant's invention the locking device is placed not at the output shaft of the tool which is subject to strikes, but instead at a location wherein it is not subject to strikes, in particular at the intermediate shaft. It provides for significant advantages: a locking device is not subjected to strikes and the torque of the device caused by shocks or anything alike is reduced before the gearing. However, these advantages had not been known before the time the present application was filed. Any reasoning that someone skilled in the art would have placed the locking device anywhere else but in the output shaft of the tool is therefore hindsight reasoning. Thus, it is again emphasized that while the locking device allows clamping and releasing a tool with respect to the output shaft or the drilling spindle, or connecting and disconnecting the tool holder with respect to the output shaft or the drilling spindle, it is also located so that it is not subject to strikes of the impact mechanism, or in other words the axial percussion movement of the drilling spindle does not provide a disturbing influence on the arresting of the drilling spindle (as explained in the second paragraph on page 5 of the specification).

None of the references disclose in a single word and does not contain any hint or suggestion that an arresting device can be provided which performs the above mentioned functions, and at the same time is not subject to strikes of the impact mechanism. Neither Tsai nor Bitter recognize the problems of providing an arresting device which is reliably protected from the strikes.

As for obviousness of the present invention from the combination of the teachings of the references alleged by the Examiner, applicants wish to make the following remarks.

First of all there is no hint or suggestion why a person of ordinary skill in the art would combine the references, since the references did not contain any incentive for such a combination. However, if for the sake of argument it is admitted that the references are combinable, a hand power tool produced from the combination of the teachings of the patent to Bitter and Tsai will include an arresting device of the patent to Tsai placed in the output shaft of the patent to Bitter since the patent to Tsai suggests arranging the arresting device exclusively on the output shaft of the hand power tool. The fact that a speed change mechanism can be provided does not change a simple truth that still, even with the provision of the speed

change mechanism, the only place which is contemplated with the patent to Tsai to arrange the arresting device is the output shaft of the hand power tool. Thus, a hypothetical construction produced from the combination of the teachings of the references will include an output shaft of the hand power tool or a drilling spindle of the hand power tool, an intermediate shaft which is located parallel to the output shaft of the hand power tool or the drilling spindle of the hand power tool, an arresting device, and the arrangement of the arresting device on the output shaft of the hand power tool or on the drilling spindle of the hand power tool. Since the references do not disclose any hint or suggestion for arranging the arresting device so that it is protected from strikes, a hypothetical construction produced from the combination of the references would also not include any measures which would protect the arresting device from the strikes, as defined in all independent claims and in particular in claims 17 and 18.

In contrast, the applicant's invention deals with a hand-guided percussion drilling machine wherein the arresting device, while performing its arresting functions and allowing a release of the tool or a disconnection of the tool holder, is protected from strikes, or it deals with a hand-guided percussion drilling machine in which the arresting device while allowing a

release of the tool and disconnection of the tool holder, is arranged at an intermediate shaft and is not subject to strikes.

It should be again mentioned that the intermediate shaft is definitely not the output shaft of the tool. The term "intermediate" is meant to make clear that the arresting device is placed at another shaft but not at the output shaft of the tool. In addition, it is defined in the claims that the intermediate shaft is extending parallel to the driving spindle. It makes it clear that the intermediate shaft can not be the output shaft of the tool, because one shaft can not extend parallel to itself. Therefore this feature clearly distinguishes the present invention from the prior art. Secondly, an arresting device which is placed in an output shaft is positively subjected to strikes. Strikes have to be transmitted by the output shaft and there is no other possibility. Therefore, an arresting device which is not subjected to strikes can definitely not be placed in or at an output shaft of the tool. Even this feature alone therefore serves for distinguishing the present invention from the prior art.

It is also emphasized that the location of the arresting device between the intermediate shaft and the housing or its component is also not disclosed in the references. In the Tsai patent the arresting device is located

between 2 parts of the shaft. To say that the arresting device of Tsai is located physically between the intermediate shaft and the housing of Bitter is the same as to say that it is located between the ground and the sky. In the Tsai-Bitter combination the arresting device will be located between the parts of Tsai shaft, with both shaft parts spaced from the Bitter housing.

While a combination of the references could lead to a hand power tool with an output shaft, an intermediate shaft which is parallel to the output shaft, and an arresting device, the references do not contain any hint or suggestion to arrange the arresting device on the intermediate shaft which is offset from and extends parallel to the output shaft. Any suggestion by the Examiner to arrange the arresting device at the intermediate shaft which is offset from and is parallel to the output shaft can be qualified only as an impermissible reconstruction of the constructions disclosed in the references and redesigning a hypothetical prior art construction to be deliberately similar to the construction disclosed in the present application. In addition, this impermissible redesigning of the prior art to be similar to the present application involves imparting to the hypothetical non-existent prior art construction such properties and advantages (protection from strikes) which have never been thought in the prior art and have never been achieved in the prior art.

It is believed to be clear that the present invention deals with a hand power tool including the new features that are not disclosed in the references or their combination. In order to arrive at the applicant's invention the references have to be fundamentally modified by including into them exactly those features which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestion for modification of their constructions so as to provide an arresting device which is not subjected to strikes, or an arresting device which is arranged at an intermediate shaft and not subjected to strikes.

As explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the constructions disclosed in the references.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

The significant advantages provided by the applicant's invention in protecting the arresting device from strikes, is an additional clear indication that the present invention can not be considered as obvious from the references either taken singly or in combination with one another, since none of the references either taken singly or in combination with one another would provide highly advantageous results which can be accomplished by the applicant's invention.

In view of the above presented remarks and amendments, it is believed that the independent claims currently on file should be considered as patentably distinguishing the present invention from the prior art and they should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share its presumably allowable features, and therefore it is respectfully submitted that these claims should be allowed as well.

COMMERCIAL SUCCESS

It is very important to point out that applicant's invention has met with considerable commercial success. The commercial success of an invention is a strong consideration with respect to the issue of patentability.

In this case, the proofs presented relate to sales within the Country of Germany alone, although the product has also been sold in other countries. The Country of Germany is the home country of the inventors and the assignee of the inventors, Robert Bosch GmbH.

Attached hereto are Declarations of Dr. Christian Heine, a Product Manager of the applicant, as well as Thomas Iseli, a Project Leader also employed by Robert Bosch GmbH. The Declarations clearly state that the commercial success of the product is a result of the new inventive features which are now defined in the independent claims of the present application.

Attached to the Declaration of Dr. Christian Heine are numerous exhibits and charts showing the explosive commercial success of applicant's invention.

Note also, that the inventive features is now installed on no less than 22 Robert Bosch GmbH power tools.

The graph submitted as Exhibit "A" to the Heine Declaration illustrates the substantial impact this feature has had upon the market share within Robert Bosch GmbH sales.

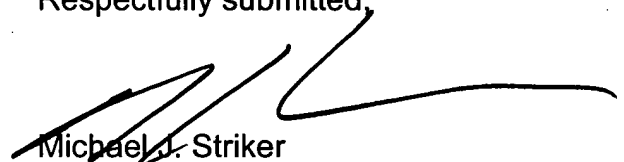
The commercial success summarized above and proved through the Declarations and various exhibits submitted herewith, prove that the inventive features of the subject invention rise to the standard of

patentability. Commercial success should be given strong probative value in determining the patentability of an invention.

Reconsideration and allowance of present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, she is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

Michael J. Striker
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